

02/07/02  
1130 U.S. PTO

PATENT

Attorney's Docket Number: 02481.1732-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

Prior Application: Art Unit: 1636  
Examiner: Not Yet Assigned

JC868 U.S. PTO  
10/06/02  
02/07/02

SIR: This is a request for filing a

☒ Continuation ☐ Continuation-in-Part ☐ Divisional Application under 37 C.F.R. § 1.53(b) of pending prior application Serial No. of Hans-Willi JANSEN et al. for PROCESS FOR IDENTIFYING SUBSTANCES WHICH MODULATE THE ACTIVITY OF HYPERPOLARIZATION-ACTIVATED CATION CHANNELS.

1. ☒ Enclosed is a complete copy of the prior application including the oath or Declaration as originally filed. I hereby verify that the attached papers are a true copy of prior application Serial No. 09/779,587 as originally filed on February 9, 2001, which is incorporated herein by reference.
2. ☐ Enclosed is a substitute specification under 37 C.F.R. § 1.125.
3. ☐ Enclosed is a Request for Non-Publication of Application and Certification Under 35 U.S.C. § 1.22(b)(2)(B)(i).
4. ☐ Cancel Claims \_\_\_\_\_.
5. ☒ A Preliminary Amendment is enclosed.
6. ☒ The filing fee is calculated on the basis of the claims existing in the prior application as amended at 4 and 5 above.

LAW OFFICES

NNEGAN, HENDERSON,  
FARABOW, GARRETT,  
& DUNNER, L.L.P.  
1300 I STREET, N. W.  
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202-408-4000

Basic Application Filing Fee					\$740	\$ 740.00
	Number of Claims		Basic	Extra Claims		
Total Claims	65	-	20	45	x \$18	810.00
Independent Claims	3	-	3	0	x \$84	
[ ] Presentation of Multiple Dep. Claim(s)					+\$280	
					Subtotal	\$ 1,550.00
					Reduction by ½ if small entity	-
					TOTAL APPLICATION FILING FEE	\$ 1,550.00

7. ☒ A check in the amount of \$1,550.00 to cover the filing fee is enclosed.
8. ☒ The Commissioner is hereby authorized to charge any fees which may be required including fees due under 37 C.F.R. § 1.16 and any other fees due under 37 C.F.R. § 1.17, or credit any overpayment during the pendency of this application to Deposit Account No. 06-0916. **Please do not charge the filing fee to the above Deposit Account.**
9. ☒ Amend the specification by inserting before the first line, the sentence:  
  
--This is a continuation of application Serial No. 09/779,587, filed February 9, 2001, now abandoned, which is incorporated herein by reference.--
10. ☐ New formal drawings are enclosed.
11. ☒ The prior application is assigned of record to: Aventis Pharma Deutschland GmbH.
12. ☒ Priority of Application No. 100 06 309.8, filed on February 12, 2000 in Germany is claimed under 35 U.S.C. § 119. A certified copy  
  
☐ is enclosed or ☒ is on file in the prior application.
13. ☐ Small entity status is appropriate and is requested for this application.
14. ☒ The power of attorney in the prior application is to at least one of the following: FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P., Douglas B. Henderson, Reg. No. 20,291; Ford F. Farabow, Jr., Reg. No. 20,630;

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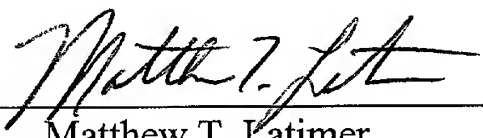
Arthur S. Garrett, Reg. No. 20,338; Donald R. Dunner, Reg. No. 19,073; Brian G. Brunsvold, Reg. No. 22,593; Tipton D. Jennings, IV, Reg. No. 20,645; Jerry D. Voight, Reg. No. 23,020; Laurence R. Hefter, Reg. No. 20,827; Kenneth E. Payne, Reg. No. 23,098; Herbert H. Mintz, Reg. No. 26,691; C. Larry O'Rourke, Reg. No. 26,014; Albert J. Santorelli, Reg. No. 22,610; Michael C. Elmer, Reg. No. 25,857; Richard H. Smith, Reg. No. 20,609; Stephen L. Peterson, Reg. No. 26,325; John M. Romary, Reg. No. 26,331; Bruce C. Zotter, Reg. No. 27,680; Dennis P. O'Reilley, Reg. No. 27,932; Allen M. Sokal, Reg. No. 26,695; Robert D. Bajefsky, Reg. No. 25,387; Richard L. Stroup, Reg. No. 28,478; David W. Hill, Reg. No. 28,220; Thomas L. Irving, Reg. No. 28,619; Charles E. Lipsey, Reg. No. 28,165; Thomas W. Winland, Reg. No. 27,605; Basil J. Lewris, Reg. No. 28,818; Martin I. Fuchs, Reg. No. 28,508; E. Robert Yoches, Reg. No. 30,120; Barry W. Graham, Reg. No. 29,924; Susan Haberman Griffen, Reg. No. 30,907; Richard B. Racine, Reg. No. 30,415; Thomas H. Jenkins, Reg. No. 30,857; Robert E. Converse, Jr., Reg. No. 27,432; Clair X. Mullen, Jr., Reg. No. 20,348; Christopher P. Foley, Reg. No. 31,354; John C. Paul, Reg. No. 30,413; David M. Kelly, Reg. No. 30,953; Kenneth J. Meyers, Reg. No. 25,146; Carol P. Einaudi, Reg. No. 32,220; Walter Y. Boyd, Jr., Reg. No. 31,738; Steven M. Anzalone, Reg. No. 32,095; Jean B. Fordis, Reg. No. 32,984; Roger D. Taylor, Reg. 28,992; Barbara C. McCurdy, Reg. No. 32,120; James K. Hammond, Reg. No. 31,964; Richard V. Burgujian, Reg. No. 31,744; J. Michael Jakes, Reg. No. 32,824; Thomas W. Banks, Reg. No. 32,719; Christopher P. Isaac, Reg. No. 32,616; Bryan C. Diner, Reg. No. 32,409; M. Paul Barker, Reg. No. 32,013; Andrew Chanho Sonu, Reg. No. 33,457; David S. Forman, Reg. No. 33,694; Vincent P. Kovalick, Reg. No. 32,867; James W. Edmondson, Reg. No. 33,871; Michael R. McGurk, Reg. No. 32,045; Joann M. Neth, Reg. No. 36,363; Gerson S. Panitch, Reg. No. 33,751; Cheri M. Taylor, Reg. No. 33,216; Charles E. Van Horn, Reg. No. 40,266; Linda A. Wadler, Reg. No. 33,218; Jeffrey A. Berkowitz, Reg. No. 36,743; Michael R. Kelly, Reg. No. 33, 921; James B. Monroe, Reg. No. 33,971; Doris Johnson Hines, Reg. No. 34,629; Allen R. Jensen, Reg. No. 28,224; Lori Ann Johnson, Reg. No. 34,498; and David A. Manspeizer, Reg. No. 37,540.

15. ■ The power appears in the original declaration of the prior application.
16. □ Since the power does not appear in the original declaration, a copy of the power in the prior application is enclosed.
17. ■ Please address all correspondence to FINNEGAN, HENDERSON, FARABOW, GARRETT and DUNNER, L.L.P., 1300 I Street, N.W., Washington, D.C. 20005-3315, **Customer Number 22,852.**

18. ☐ Recognize as associate attorney \_\_\_\_\_  
\_\_\_\_\_  
(name, address & Reg. No.)
19. ☐ Also enclosed is \_\_\_\_\_  
\_\_\_\_\_

**PETITION FOR EXTENSION.** If any extension of time is necessary for the filing of this application, including any extension in the parent application, Application No. 09/779,587, filed February 9, 2001, for the purpose of maintaining copendency between the parent application and this application, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to our Deposit Account No. 06-0916. A duplicate copy of this paper is enclosed for use in charging the deposit account. **Please do not charge the filing fee to the Deposit Account.**

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
Matthew T. Latimer  
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Date: February 7, 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Rule 53(b) Continuation )  
Application of: )  
Hans-Willi JANSEN et al. )  
Parent Application No.: 09/779,587 ) Parent Group Art Unit: 1636  
Parent Filed: February 9, 2001 ) Examiner: Not Yet Assigned

For: PROCESS FOR IDENTIFYING SUBSTANCES WHICH MODULATE THE  
ACTIVITY OF HYPERPOLARIZATION-ACTIVATED CATION CHANNELS

Assistant Commissioner for Patents  
Washington, D.C. 20231

**PETITION TO ACCEPT APPLICATION WITHOUT DRAWINGS**

Sir:

In a Notice of Incomplete Nonprovisional Application mailed in parent application Serial No. 09/779,587, dated December 7, 2001, the Office indicated that, although the specification of the application made reference to drawings (figures), no drawings were filed with the application. Applicants submit that the drawings (Figures 1 and 2) discussed in the text of the specification are not necessary for the understanding of the subject matter sought to be patented. Therefore, Applicants submit that the drawings are not required under 35 U.S.C. § 113.

The present invention and an advantage it provides over previously known methods are briefly summarized in the specification, on page 14, lines 20-24. The two figures referenced in the specification depict examples of results obtained according to practice of the invention with a combination of a publicly-available instrument (FLIPR, Molecular Devices, Sunnyvale CA; see

the specification at page 11, lines 27-28 and page 21, line 7 through page 22, line 8) and well-known and widely used cations (sodium ( $\text{Na}^+$ ), potassium ( $\text{K}^+$ ), and cesium ( $\text{Cs}^+$ )), cation channel modulators (forskolin and zatebradine; see the specification at page 3, lines 15-28 and page 9, lines 15-27) , and ion channels (HCN family; see the specification at page 10, lines 9-12), all of whose identities and modes of action are known to those of skill in the art. (See the specification at page 21, line 17 through page 22, line 8; and page 22, line 21 through page 23, line 3.) The figures do not provide necessary information for understanding the invention, but merely show examples of results that can be obtained by practicing the invention.

Furthermore, the invention is not limited to the instrument, cations, modulators, and channels used to generate the data of the figures. Rather, the invention can be practiced using various instruments that are publicly available from various scientific instrument suppliers. (See, for example, the specification at page 5, lines 1-6.) Likewise, it can be practiced on numerous ion channels that are affect by various different modulators and cations. (See the specification at page 9, lines 15-27; page 10, lines 9-23; page 14, lines 20-26; and page 15, lines 12-17.) Thus, the invention is not limited to the instrument, cation channel, cation, or modulator used in the experiments presented as the figures of the application. Accordingly, the data provided by the figures is not necessary to understand or practice the invention, but merely illustrative of one embodiment of it.

Finally, the text of the specification, without the figures, clearly and adequately describes the full scope of the claimed invention. See, for example, page 20, line 15 through page 21, line 15 (according to the paragraph, as amended by the Preliminary Amendment filed herewith); and

page 22, lines 23-19 (according to the paragraph, as amended by the Preliminary Amendment filed herewith).

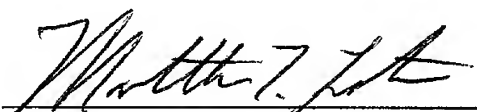
In view of the above discussion, Applicants respectfully submit that the specification fully describes the subject matter of the claimed invention without any need for either of Figures 1 and 2. Accordingly, the figures and accompanying text (which is deleted by the Preliminary Amendment filed herewith) are not necessary for the understanding of the subject matter sought to be patented, and are thus not required under 35 U.S.C. § 113. Therefore, Applicants respectfully request that the Office accord this application the filing date of February 7, 2002, and enter the accompanying Preliminary Amendment, which eliminates the text relating to Figures 1 and 2.

The required Petition fee under 37 C.F.R. § 1.17(h) of \$130.00 is attached hereto. Because this application is entitled to the filing date of February 7, 2002, Applicants request that the attached Petition fee be refunded upon granting of the filing date by the Office.

If there is any other fee due in connection with the filing of this Petition, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
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Date: February 7, 2002

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